REMARKS

I. Support for the Amendments

The present application is a 35 U.S.C. §371 national stage of PCT application PCT/JP99/07198, filed December 22, 1999, which claims priority of Japanese Application Serial Number 366719/1998, filed December 24, 1998, the disclosures of all of which are incorporated herein by reference. Support for the amendment to the specification inserting the Cross-References to Related Applications can be found in the transmittal papers, in the published PCT application, and in the Declaration & Power of Attorney.

Claims 1-8, 11, 15, and 16 are presently in the application. Claims 1-4, 6, 8 and 11 have been amended, and new claims 15 and 16 have been added. The amendments to claims 2-4 and 6 are largely a matter of form.

Support for amended claims 1-4, 6, 8 and 11 and for new claims 15 and 16 can be found in the original specification and claims. Additional support for amended claims 1-4 and new claim 16 can be found, e.g., on page 14, lines 5-14; from page 15, line 3, to page 17, line 31; and in the Examples. Additional support for amended claim 8 can be found, e.g., on page 15, lines 20-26; from page 15, line 3, to page 17, line 31; and in the Examples. Additional support for amended claim 11 and for new claims 15 and 16 can be found, e.g., from page 16, line 4, to page 17, line 31; from page 15, line 3, to page 17, line 31; and in the Examples. The amendments to claims 2-4 and 6 are largely a matter of form.

II. Status of the Claims

Claims 1-14 were originally in the application, with claim 1 being the independent claim. Claims 1-14 were subject to an Election/Restriction Requirement, and claims 1-8 and 11 (Group I) were elected with traverse.

In the Office Action mailed January 13, 2004, the Examiner rejoined claims 9-10, but stated that the restriction requirement remains in force for claims 12-14. The Examiner rejected claims 1-11, which were all the remaining claims.

Claims 1-11 were pending in the application, with claim 1 being the independent claim.

In the previous amendment, claims 1-8 and 11 were in the application. Claims 1 and 11 were the independent claims. In order to further prosecution in a timely manner, claims 9-10 and non-elected claims 12-14 were cancelled without prejudice to their pursuit in an appropriate continuation or divisional application.

Claims 1-8, 11, 15, and 16 are currently in the application. Claims 1-4, 6, 8, and 11 have been amended and new claims 15 and 16 have been added. Claims 2-8 are dependent on claim 1, and claims 15 and 16 are dependent on claim 11.

III. Acknowledgement of the Drawings

The Examiner has acknowledged the replacement drawings received on May 14, 2004 and notes that they have been accepted. Applicants thank the Examiner accordingly.

IV. Acknowledgement of the Sequence Listing

The Examiner has acknowledged the replacement paper copy of the sequence listing, corresponding computer readable form (CRF), and attorney's statement and notes that the application is now in sequence compliance. Applicants thank the Examiner accordingly.

V. Remarks Concerning the Information Disclosure Statement

The Examiner had previously signed and initialed the PTO Form 1449 filed on June 21, 2001, but did not sign and initial the PTO Form 1449 filed on October 7, 2003, and also maintained that the Information Disclosure Statement was not in compliance for failure to submit copies of references.

In the previous Amendment, mailed May 12, 2004, Applicants respectfully submitted, however, that the references and copy of the European Search Report were filed concurrently with this IDS (note Certificate of Mailing) in accordance with the discussion therein. Applicants respectfully submitted, therefore, that a new IDS was not necessary, although Applicants' representative agreed to re-submit copies of the references during the telephone interview of January 23, 2004. In accordance with the Examiner's instructions during the telephonic interview, Applicants note that no additional fee is due for this IDS, because it was submitted previously.

In the present Office Action, the Examiner acknowledged the Information Disclosure Statements and initialed the references cited therein. Applicants thank the Examiner for acknowledging these references.

VI. The Rejection of Claims 1-8 and 11 under 35 U.S.C. §112, Second Paragraph is Accommodated

The Examiner has rejected claims 1-8 and 11 under 35 U.S.C. §112, second paragraph (pp. 3-5).

The Patent Office alleges:

> Claims 1-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. **The following are new rejections.**
>
> Claim 1 recites the limitation of an isolated DNA or promoter region "containing" a regulator sequence. The term "containing" is not explicitly defined in the instant specification and it is not clear whether the term is meant to be open (e.g. comprising) or closed language (e.g. consisting of), making the metes and bounds of the DNA claimed unclear. It would be remedial to amend the claim to include language that is explicitly open (e.g. comprising) or closed (e.g. consisting of) with regard to the presence of additional elements.
>
> Claim 1 lacks articles (e.g. "a" or "the") prior to several elements of the claim (e.g. "uncoupling protein-2 (UCP-2) promoter region" or "peroxisome proliferator response element (PPRE)")....Claims 2, 3, 6 and 11 also lack articles prior to specific elements recited in the claim...
>
> Claim 1 is vague and indefinite in that the metes and bounds of the phrase "wherein the regulator sequence is at least any one of the sequences selected from" are unclear. It is unclear whether the term "is" is necessarily closed language or not. It would be remedial to amend the claim to include language that is explicitly open (e.g. comprising) or closed (e.g. consisting of) with regard to the presence of additional elements.
>
> Claim 1 is further vague and indefinite in that the metes and bounds of the phrase "presented by" with regard to sequences within SEQ ID NO: 1. The term is not explicitly defined in the instant specification and it is unclear whether the term specifies that the particular nucleotide residues recited in the claims are necessarily present in the claimed nucleic acids or that the claimed sequences merely comprise nucleotide residues that "correspond to" or are "represented by" the specific recited residues of SEQ ID NO: 1. it would be remedial to amend the rejected claims to clearly indicate which of the two possibilities is intended by the term "presented by" (e.g. "comprising nucleotides 284 to 296 of SEQ ID NO: 1").

> Claim 1 is vague and indefinite in that the metes and bounds of the term "a sequence comprising MyoD" are unclear. It is unclear if MyoD is a protein or is a protein-binding site within the polynucleotide sequence of SEQ ID NO: 1. If the term actually refers to a protein-binding site within the polynucleotide sequence of SEQ ID NO: 1, it would be remedial to amend the claim to something like "a sequence comprising a MyoD-binding sequence".
>
> Claim 8 is vague and: indefinite in that there is no clear and positive prior antecedent basis for the phrase "the transformant lacking the UDP-2 promoter contacted to the test compounds.
>
> Claim 11 is vague and indefinite in that the metes and bounds of the phrase "cell differentiation medium" are unclear....
>
> Claim 11 is further vague and indefinite in that the metes and bounds of the phrase "plasmid for measurement of UCP-2 promoter activity" are unclear. The instant specification does not clearly indicate that is considered to be the minimal elements required for a plasmid to satisfy the limitation of being a "plasmid for measurement of UCP-2 promoter activity"....
>
> Claim 11 is vague and indefinite in that it is unclear how a kit can "consist of' only the elements recited in the rejected claim (i.e. two different types of media, a plasmid(s) for measurement of UCP-2 promoter activity, host cell line and test compounds). [Pp. 3-5; emphasis in original.]

With respect to the above remarks concerning claims 1-8, the language of claim 1 presently reads as follows:

> 1 (currently amended). An isolated DNA containing uncoupling protein-2 (UCP-2) promoter region comprising a regulator sequence, wherein the regulator sequence is a sequence selected from the group consisting of:
>
> a. a peroxisome proliferator response element (PPRE) sequence comprising nucleotides 284 to 296 of SEQ ID NO: 1;
> b. a CCAAT/enhancer binding protein (C/EBP) sequence comprising nucleotides 1316 to 1320 of SEQ ID NO: 1, nucleotides 1364 to 1368 of SEQ ID NO: 1, or nucleotides 1698 to 1692 of SEQ ID NO: 1;
> c. a glucocorticoid response element (GRE) sequence comprising nucleotides 753 to 758 of SEQ ID NO: 1, nucleotides 1023 to 1030 of SEQ ID NO: 1, or nucleotides 1450 to 1455 of SEQ ID NO: 1; and
> d. a MyoD-binding sequence comprising nucleotides 1428 to 1437 of SEQ ID NO: 1.

Applicants respectfully submit that the present claim 1 addresses all of the Examiner's remarks. Claims 2-8 are dependent on claim 1. Applicants have also amended claims 2-4, 6, and 8 to accommodate the Examiner's remarks concerning those claims as well.

The language of claim 11 presently reads as follows:

> 11 (currently amended). A kit for screening a test compound or its salt that promotes or inhibits UCP-2 promoter activity, which comprises:
> a. a cell culture medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with fetal calf serum (FCS);
> b. a cell differentiation medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with rabbit serum;
> c. a plasmid for measurement of UCP-2 promoter activity comprising:
> i. a pGL3-basic plasmid DNA carrying the UCP-2 promoter sequence; and
> ii. a structural gene inserted downstream of the UCP-2 promoter;
> d. a host cell line comprising an MG-63 cell line; and
> e. a test compound or its salt.

Applicants respectfully submit that the present claim 11 addresses all of the Examiner's remarks.

Applicants respectfully submit that the present amendments to claims 1-4, 6, 8, and 11 accommodate the Examiner's rejection of these claims under 35 U.S.C. §112, second paragraph, thereby placing these claims in condition for allowance.

VII. The Rejection of Claim 11 Under 35 U.S.C. §112, First Paragraph, is Traversed, but Accommodated

The Examiner has rejected claim 11 under 35 U.S.C. §112, first paragraph (pp. 5-6). The Patent Office alleges:

The rejected claim is directed to a "kit" comprising the following elements: two different types of media, a plasmid(s) for measurement of UCP-2 promoter activity, host cell line and test compounds. The term "a plasmid(s) for measurement of UCP-2 promoter activity" is not clearly defined in the instant specification and can be interpreted broadly to read on any type of plasmid that may be used, directly or indirectly, to measure UCP-2 promoter activity. Similarly, the term "cell differentiation medium" is not clearly defined and can be interpreted broadly to encompass any type of media in which any type of cell can undergo any degree of differentiation under any conditions. Further, the claim encompasses literally any type of test compound that might be used in any assay, direct or indirect, that measures UCP-2 promoter activity. Thus, the rejected claims encompass an enormous genus of different combinations of elements, each of which is recited in enormously broad terms.

Given that the instant specification appears to be directed to a very specific set of hUCP-2 promoter sequences (i.e. SEQ ID-NO: 1), that only 1 example is provided for what constitutes a "cell differentiation" medium and that the description provided for what constitutes a "test compound" is only generic with regard to classes of different compounds, and given the enormous genus of combinations of elements recited by the rejected claim, the skilled artisan would not have been able to envision a sufficient number of specific embodiments of the claimed invention to described the broadly claimed genus. Therefore, the skilled artisan would reasonably have concluded applicants were not in possession of the claimed invention. [Pp. 5-6.]

Applicants respectfully disagree, but have amended claim 11 in the interests of furthering prosecution of the application. The language of claim 11 presently reads:

11 (currently amended). A kit for screening a test compound or its salt that promotes or inhibits UCP-2 promoter activity, which comprises:

a. a cell culture medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with fetal calf serum (FCS);
b. a cell differentiation medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with rabbit serum;
c. a plasmid for measurement of UCP-2 promoter activity comprising:
   i. a pGL3-basic plasmid DNA carrying the UCP-2 promoter sequence; and
   ii. a structural gene inserted downstream of the UCP-2 promoter;
d. a host cell line comprising an MG-63 cell line; and
e. a test compound or its salt.

Applicants also respectfully submit that the present amendments to claim 11 accommodate the Examiner's rejection of these claims under 35 U.S.C. §112, first paragraph, thereby placing these claims in condition for allowance.

VIII. The Rejection of Claim 11 Under 35 U.S.C. §102(b) Is Traversed, but Accommodated

The Examiner has rejected claim 11 under 35 U.S.C. §102(b) "as being anticipated by Amaral et al. (U.S. Patent No. 5,807,740 issued 9/15/1998) or Amaral et al. (U.S. Patent No. 5,849,514 issued 12/15/1998)" (pp. 6-7). Applicants respectfully disagree.

The Patent Office alleges:

> The rejected claim is directed to a "kit" comprising the following elements: two different types of media, a plasmid(s) for measurement of UCP-2 promoter activity, host cell line and test compounds. The term "a plasmid(s) for measurement of UCP-2 promoter activity" is not clearly defined in the instant specification and can be interpreted broadly to read on any type of plasmid that may be used, directly or indirectly, to measure UCP-2 promoter activity. Similarly, the term "cell differentiation medium" is not clearly defined and can be interpreted broadly to encompass any type of media in which any type of cell can undergo any degree of differentiation under any conditions. Further, the claim encompasses literally any type of test compound that might be used in any assay, direct or indirect, that measures UCP-2 promoter activity. Thus, the rejected claims encompass an enormous genus of different combinations of elements, each of which is recited in enormously broad terms.
>
> Both patents disclose DNA containing a promoter region which includes a human UCP-2 regulator sequence and has a nucleotide sequence that coincides with bases 1762 to 2280 of SEQ ID NO: 1 (e.g. a "part thereof" as in claim 4). In particular, cells transformed with UCP-2 promoters operably linked to reporter genes are taught for use in drug screening assays (e.g. Abstract, columns 3-4). The cell media disclosed by the patents (e.g. DMEM/F12/12% FBS) can reasonably be interpreted to be both a cell growth media as well as a "cell differentiation" media given the lack of a clear definition for what constitutes a "cell growth medium". Therefore, both patents anticipate the claimed kit. [Pp. 6-7.]

Applicants disagree, but have amended the language of claim 11 to accommodate the Examiner's rejection under 35 U.S.C. §112, second paragraph. The present language of claim 11 reads as follows:

> 11 (currently amended). A kit for screening a test compound or its salt that promotes or inhibits UCP-2 promoter activity, which comprises:
>
> a. a cell culture medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with fetal calf serum (FCS);
>
> b. a cell differentiation medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with rabbit serum;
>
> c. a plasmid for measurement of UCP-2 promoter activity comprising:
>
> i. a pGL3-basic plasmid DNA carrying the UCP-2 promoter sequence; and
>
> ii. a structural gene inserted downstream of the UCP-2 promoter;
>
> d. a host cell line comprising an MG-63 cell line; and
>
> e. a test compound or its salt.

Amaral '740 and Amaral ''514 fail to disclose the FCS-supplemented DMEM cell culture medium and the rabbit serum-supplemented DMEM cell differentiation medium, along with other elements of the kit, as described in the present language of claim 11.

Applicants respectfully submit that the present claim 11 fulfills the requirements of 35 U.S.C. §102(b) and request the Examiner's reconsideration of this claim accordingly.

IX. The Rejection of Claims 1-8 and 11 Under 35 U.S.C. §102(b) Is Traversed

The Examiner has rejected claims 1-8 and 11 under 35 U.S.C. §102(b) "as being anticipated by Surwit et al. (WO 98/31396; see the entire PCT application)." Applicants respectfully disagree.

The Patent Office alleges:

> Claims 1-8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Surwit et al (WO 98/31396; see the entire PCT application). **This is a new rejection.**
>
> The Surwit et al application teaches the identification and cloning of nucleic acid sequences encoding human uncoupling protein 2(hUCP-2), 5' sequences controlling the expression of hUCP-2 as well as methods of using the regulator sequences to identify modulators of hUCP-2 expression. For example, the application teaches the identification of a human BAC clone comprising approximately 20 kb of human sequence which the practitioners believe comprises the entire gene and entire promoter (hUCP2.BAC deposited with the ATCC; e.g. see pages 16-17). Further, the application teaches the isolation of a lambda EMBL3 phage comprising ~14 kb of human sequences. This clone comprises all 8 exons of the human UCP-2 gene, as well as a minimum of 3 kb of DNA upstream of the putative +1 site (e.g. page 32). The application teaches methods of screening compounds for the ability to modulate (e.g. increase or inhibit) the activity or expression of UCP-2. Such methods can be performed *in vivo* or *in vitro* using cells expressing the human UCP-2 gene (or cells expressing a reporter sequence operatively linked to the UCP-2 regulatory sequences) that are incubated in the presence and absence of test compounds and the level of expression in each case determined (e.g. page 19, lines 2-18). As indicated above, the term "cell differentiation medium" is not clearly and explicitly defined in the instant specification and can thus be read broadly to encompass any media used to culture any of the types of cells taught by Surwit et al.
>
> Given the size of the genomic clones obtained by the inventors of the Surwit et al application (e.g. at least 3 kb upstream of the transcription initiation site) and the fact that the sequences recited in the recent claims are all within ~2.2. kb of the initiation site (e.g. see amended Figure 4 of the instant specification), it is reasonable to expect that the clones obtained by Surwit et al necessarily comprise the specific sequences recited in rejected claims 1-8. Because the Office does not have the facilities for examining and comparing the applicant's product with the products of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed products and the products of the prior art (e.g. that the products of the prior art do not possess the same material structural and functional characteristics of the claimed product). See in re Best, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977). [Pp. 8-9.]

Applicants respectfully disagree with these comments and traverse the anticipation rejection.

As noted, the present language of claim 1 reads as follows:

> 1 (currently amended). An isolated DNA containing uncoupling protein-2 (UCP-2) promoter region comprising a regulator sequence, wherein the regulator sequence is a sequence selected from the group consisting of:
>
> a. a peroxisome proliferator response element (PPRE) sequence comprising nucleotides 284 to 296 of SEQ ID NO: 1;
> b. a CCAAT/enhancer binding protein (C/EBP) sequence comprising nucleotides 1316 to 1320 of SEQ ID NO: 1, nucleotides 1364 to 1368 of SEQ ID NO: 1, or nucleotides 1698 to 1692 of SEQ ID NO: 1;
> c. a glucocorticoid response element (GRE) sequence comprising nucleotides 753 to 758 of SEQ ID NO: 1, nucleotides 1023 to 1030 of SEQ ID NO: 1, or nucleotides 1450 to 1455 of SEQ ID NO: 1; and
> d. a MyoD-binding sequence comprising nucleotides 1428 to 1437 of SEQ ID NO: 1.

Applicants respectfully submit that claim 1 and claim 11 in their present forms, respectively, are not anticipated by Surwit (WO 98/31396). The present application discloses promoter activity for the human UCP-2 gene and provides specific regulator sequences and experimental data regarding the same, including deletion mutants (see, e.g., p. 14, l. 1, to p. 15, l. 2, and the Examples).

In Surwit, a promoter sequence is partially disclosed. A 14 kb human DNA is described, which "contains all the 8 exons and introns, and a minimum of 3 kb of DNA upstream of the putative +1 site" (p. 32, ll. 25-27). Four regions of this clone were sequenced. Specifically, the Sequence 2 of Figure 10B, which is a sequence containing a transcription initiation site, appears to correspond to a portion of the present invention, but the two sequences are not identical and display a certain degree of variation. The first nucleotide of Sequence 2 appears to correspond to about the 1730th nucleotide of SEQ ID NO: 1 of the present application. The specification of Surwit states that "Sequence 2

corresponds to a 1161 bp DNA from positions BP –511 to +650" and that "this fragment contains the putative proximal human UCP2 promoter" (p. 33, ll. 3-5). In addition, the Sequence 1 of Figure 1A appears to be upstream of the sequence of the present invention. Surwit states that "Sequence 1 corresponds to 640 bp of DNA forming the 5' extremity of the human [UCP2] DNA" (p. 33, ll. 1-3). The "5' extremity" is "a miniumum of 3 kb of DNA upstream of the putative +1 site," which is upstream of the sequence of SEQ ID NO: 1 of the present invention. (According to Figure 9 of Surwit, Sequence 3 (Figure 10C) and Sequence 4 (Figure 10D) are downstream of the +1 site.) Further, Surwit does not clearly disclose the sequence between Sequence 1 and Sequence 2, which is where the regulator sequences specified in claim 1 would be located.

With respect to claim 1, the publication of Surwit does not include a sequence listing. As a result, the sequences recited in claim 1 are not clearly included in the disclosure of Surwit.

Applicants respectfully submit that it is impossible to consider the undisclosed sequence between Sequence 1 and Sequence 2 of Surwit. Under *In re Bell* (991 F.2d 781 (Fed. Cir. 1993)), the Federal Circuit cited the degeneracy of the genetic code as the basis for rejecting the proposition that "the established relationship in the genetic code between a nucleic acid and the protein it encodes also makes a gene prima facie obvious over its correspondent protein" (991 F.2d at 784). While it qualified the rejection by stating that "[t]his is not to say that a gene is never rendered obvious when the amino acid sequence of its coded protein is known" (991 F.2d at 784), it held that "the PTO has not met its burden of establishing that the prior art would have suggested the claimed sequences" (991 F.2d at 784). The portion of the sequence that is disclosed in Surwit is not identical to its counterpart in the present application, and there are a number of bases indicated in lower case or shown as "N," a convention in the art indicating that the base is either variable or unknown.

Claim 1 recites several sequences and their respective classifications. Surwit fails to recite or suggest these sequences, let alone their respective classifications. Thus, the Patent Office has not established prima facie anticipation or obviousness of these sequences and their respective classifications by Surwit.

The Patent Office alleges that the human BAC clone, "comprising approximately 20 kb of human sequence which the practitioners believe comprises the entire gene and entire promoter (hUCP2.BAC deposited with the ATCC; e.g., see pages 16-17)" and the lambda EMBL3 phage comprising approximately 14 kb of human sequences, which "comprises all 8 exons of the human UCP-2 gene, as well as a minimum of 3 kb of DNA upstream of the putative +1 site (e.g., page 32)" (p. 8). The Patent Office also alleges, "Given the size of the genomic clones obtained by the inventors of [Surwit] (e.g. at least 3 kb upstream of the transcription initiation site) and the fact that the sequences recited in the recent claims are all within ~2.2. kb of the initiation site, it is reasonable to expect that the clones obtained by Surwit et al necessarily comprise the specific sequences recited in rejected claims 1-8." Citing In re Best (562 F.2d 1252, 195 USPQ 430 (CCPA 1977)), the Patent Office concludes that "[b]ecause the Office does not have the facilities for examining and comparing the applicant's product with the products of the prior art, the burden is on the applicant to show a novel or unobvious difference between the claimed products and the products of the prior art (e.g. that the products of the prior art do not possess the same material structural and functional characteristics of the claimed product)."

Applicants respectfully assert that requiring Applicants to obtain one or more cell lines of Surwit and then to isolate, clone, and sequence the DNA in order to compare it with Applicants' DNA is unduly burdensome. In *Enzo*, the question was whether a deposit in a public depository constituted an adequate description to comply with 35 U.S.C. §112, ¶1 (Enzo Biochem. v. Gen-Probe, 296 F.3d 1316 (Fed. Cir. 2002) – not whether a biological

deposit could be used as prior art against a third party for purposes of anticipation (35 U.S.C. §102) or obviousness (35 U.S.C. §103). Such a holding would be unduly burdensome to practitioners.

Furthermore, where the claims are directed to a nucleotide sequence, rather than a cell line, such a holding would seem pointless, where an initial comparison of the sequences could easily be made by the Patent Office. According to the cover sheet of Surwit, the United States is one of the designated states. If Surwit has been filed in the U.S. Patent & Trademark Office, either as a national phase application under 35 U.S.C. §371 or as a *bona fide* continuation or divisional, then the Patent Office should have required submission of an electronic copy of the sequence listing of Surwit, in addition to the electronic copy submitted for the present invention, and would be in the best position to compare the two sequences. An express purpose of the electronic submission of a sequence listing enables the Patent Office to use the electronic submission for search purposes. Certainly, it is far faster, easier, and cheaper for the Patent Office to compare two electronic sequences than it is for an applicant to obtain a cell line and to isolate and sequence lengthy portions of DNA.

Even so, the date of effectiveness against a third party of the portion of the sequence listing not disclosed in the published PCT application should not be prior than the date of the submission of the undisclosed portion of the sequence listing.

Therefore, Applicants respectfully submit that the burden of proof is on the Patent Office to make a prima facie showing that the sequences recited in claim 1 are expressly disclosed in Surwit.

The present language of claim 11 reads as follows:

> 11 (currently amended). A kit for screening a test compound or its salt that promotes or inhibits UCP-2 promoter activity, which comprises:

a. a cell culture medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with fetal calf serum (FCS);
b. a cell differentiation medium comprising Dulbecco's modified Eagle's medium (DMEM) supplemented with rabbit serum;
c. a plasmid for measurement of UCP-2 promoter activity comprising:
    i. a pGL3-basic plasmid DNA carrying the UCP-2 promoter sequence; and
    ii. a structural gene inserted downstream of the UCP-2 promoter;
d. a host cell line comprising an MG-63 cell line; and
e. a test compound or its salt.

The Patent Office has cited page 19, lines 2-18, as disclosing a method of screening compounds and alleges that "the term 'cell differentiation medium' is not clearly and explicitly defined in the instant specification and can thus be read broadly to encompass any media used to culture any of the types of cells taught by Surwit. Applicants disagree, but have amended claim 11 in response to other rejections.

Applicants respectfully submit that the present claims 1-8 and 11 fulfill the requirements of 35 U.S.C. §102(b) and request the Examiner's reconsideration of these claims accordingly.

X. Conclusion

It is believed that all outstanding rejections have been addressed by this submission and that all the claims are in condition for allowance. If discussion of any amendment or remark made herein would advance this important case to allowance, the Examiner is invited to call the undersigned as soon as convenient.

In view of the foregoing amendments and remarks, the present application is respectfully considered in condition for allowance. An early reconsideration and notice of allowance are earnestly solicited.

Applicants hereby request a one-month extension of time for the Amendment and accompanying materials. If an additional extension of time is required, Applicants hereby request the Examiner to consider this a conditional petition for an extension of time. Although it is not believed that any additional fee (in addition to the fee concurrently submitted) is required to consider this submission, the Commissioner is hereby authorized to charge our deposit account no. 04-1105 should any fee be deemed necessary.

Respectfully submitted,

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